

# Notice of Allowability

Application No.

10/759,482

Examiner

Marc S. Zimmer

Applicant(s)

MORIARTY, CHRISTOPHER J.

Art Unit

1712

## -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 10/21/05.
2. ☒ The allowed claim(s) is/are 8-10 and 13-21.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
  - \* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
  - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

### Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

***Allowable Subject Matter***

Claims 8-10 and 13-21 are allowable. As before, it seems likely that the solvents specified by the claims would not be employed in ester-forming reaction systems because the normal process of esterification involves an equilibrium wherein the presence of water or alcohols would push the equilibrium in the direction of starting materials (and, hence, the large quantity of the alcohol/water that is present when these materials function as a solvating medium would largely preclude the formation of the desired ester product). Kumar et al., U.S. Patent # 6,962,963 teaches the utilization of enzymes as catalysts for promoting the reaction of a hydroxyalkyl group-functionalized polysiloxane with a dicarboxylic acid in water but the effective filing date of that reference does not antedate that of the present application. The Examiner's search was carried out with a recognition that, in order for the carrier to be one of ethanol, isopropanol, or water, there would be a strong likelihood that the solvent would have to be evaporated prior to, or concomitantly with, the reaction between the hydroxyalkyl-functional silicone and the carboxylic acid, i.e. where the materials were components of a coating composition and their product yielded a coating layer on a substrate surface. Accordingly, these materials were searched by name in connection with the various coating composition subclasses and coated article classes of the classification system but to no avail.

The Examiner even considered that claims 8-16 would even be anticipated by a reference wherein the carboxylic acid was not to be reacted with the polysiloxane but, rather, was a chemical adjuvant. The prior art mentions repeatedly the utilization of

Art Unit: 1712

carboxylic acids as condensation catalysts but, in these instances, the hydroxyl groups are bonded directly to a silicon atom as opposed to be an "organically bound" hydroxyl group.

The references made of record in this prosecution represent the closest prior art known. Insofar as they fail to even render obvious the claimed invention, the aforementioned claims are deemed allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1712

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 30, 2005

*Marc Zimmer*  
*Marc Zimmer*  
*AU 1712*